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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,749	08/01/2003	Hiroyuki Azuma	NEC 03P101	4659

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EXAMINER
SOBUTKA, PHILIP

ART UNIT	PAPER NUMBER
2618	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/632,749	AZUMA, HIROYUKI
	Examiner	Art Unit	
	Philip J. Sobutka	2618	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 April 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *20-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *20-38* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *11 May 2006* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 20-34 are rejected under 35 U.S.C. 102(b) as being anticipated by

Simpson et al (US 5,404,580).

Claim 20. Simpson teaches an external module (smart card) for installation into a

mobile communication terminal (Abstract, column 4 lines 49-52), said external module

comprising:

a collection mechanism (keypad interface) for communicating with said mobile

communication terminal to collect information relating to an internal state of said mobile

communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et

al. disclose customizing the operation (information relating to the internal state) of the

mobile to his personal preference and storing the customizing data, hence the data is

collected); and

a storage mechanism for storing therein information that has been collected by

said collection mechanism (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element

132).

As to claim 21, Simpson teaches an external module according to claim 20,

further comprising: protocol execution mechanism for requesting said mobile

communication terminal to execute a communication protocol sequence (Column 4 lines 53-56, where Simpson et al. describe a registration request).

As to claim 22, Simpson teaches an external module according to claim 21, wherein said protocol execution mechanism includes a mechanism for requesting the execution of said communication protocol sequence based on information that has been stored in said storage mechanism (Column 4 lines 53-56, where Simpson et al. disclose a subscriber validation code).

As to claim 23, Simpson teaches an external module according to claim 21, wherein said communication protocol sequence is a communication protocol sequence that is performed by radio between a mobile communication terminal and a base station (Column 4 lines 53-56).

As to claim 24, Simpson teaches an external module according to claim 20, further comprising stored information processing mechanism (microprocessor) for processing information that has been stored in said storage mechanism (Column 4 lines 53-56.

As to claim 25, Simpson teaches an external module according to claim 24, wherein said protocol execution mechanism includes a mechanism for requesting the execution of a communication protocol sequence (registration) based on information that has been processed by said stored information processing mechanism (Column 4 lines 53-56).

As to claim 26, Simpson teaches an external module according to claim 20, wherein said external module is any one of a SIM card, a USIM card, and an IC card

having higher specifications than a SIM card or USIM card (abstract, column 2, lines 28-36).

Consider claim 27. Simpson teaches a mobile communication terminal into which an external module is installed (Abstract, column 4 lines 49-52), said mobile communication terminal comprising:

an acquisition mechanism (keypad) for acquiring information relating to an internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is acquired by the mobile terminal); and

an output mechanism for supplying information that has been acquired by said acquisition mechanism to said external module where the information is stored (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122).

Consider claim 28. Simpson teaches a mobile communication system comprising:

a mobile communication terminal (abstract); and

an external module for installation into said mobile communication terminal (Abstract, column 4 lines 49-52);

wherein said mobile communication terminal comprises:

an acquisition mechanism for acquiring information relating to an internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is acquired by the mobile terminal); and

an output mechanism (keypad and microprocessor) for supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122);

and wherein said external module comprises:

a collection mechanism for collecting information that has been supplied by said output mechanism of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and

a storage mechanism for storing therein information that has been collected by said collection mechanism (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claim 29. Simpson teaches a method for testing communication protocol in a mobile communication terminal (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4), an external module being installed into said mobile communication terminal (Abstract, column 4 lines 49-52), said method comprising the steps of:

requesting said mobile communication terminal, by said external module, to

execute a communication protocol sequence Column 4 lines 53-56, where Simpson et

al. describe a registration request);

executing, by said mobile communication terminal, said communication protocol

sequence in accordance with said request by Said external module (Column 4 lines 56-

57, where Simpson et al. disclose a registered subscriber);

acquiring, by said mobile communication terminal (keypad), information relating

to an internal state of said mobile communication terminal (Column 6 lines 48-68,

column 7 lines 1-2);

supplying, by said mobile communication terminal, the acquired information to

said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122);

collecting, by said external module, information that has been supplied by said

mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and

storing, in said external module, the collected information (Column 6 lines 48- 68,

column 7 lines 1-2, figure 3 element 132).

As to claim 30, Simpson teaches an method according to claim 29, wherein said

step of requesting to execute a communication protocol sequence includes requesting,

by said external module to execute said communication protocol sequence based on

information that is stored (Column 4 lines 53-56, where Simpson et al. disclose a

subscriber validation code).

As to claim 31, Simpson teaches an method according to claim 29, wherein said step of executing a communication protocol sequence includes execution by said mobile communication terminal of a communication protocol sequence by radio with a base station (Column 4 lines 53-56).

As to claim 32, Simpson teaches an method according to claim 29, further comprising a step of processing information that is stored in said external module (Column 4 lines 49-56).

As to claim 33, Simpson teaches an method according to claim 32, wherein said step of executing a communication protocol sequence includes requesting, by said external module, execution of a communication protocol sequence based on information that has been processed (Column 4 lines 53-57).

As to claim 34, Simpson teaches an method according to claim 29, wherein said external module is any one of a SIM card, a USIM card, and an IC card having higher specifications than a SIiM card or a USIM card (abstract, column 2, lines 28-36).

3.   Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al (US 5,404,580) in view of Rimpela et al (US 6,697,604).

Consider claim 35, Simpson et al. disclose an external module for installation in a mobile communication terminal (Abstract, column 4 lines 49-52), said external module comprising;

a program execution unit (Column 1 lines 16-30, column 2 lines 65-68, column 3

lines 1-4, where Simpson et al. disclose enhancing a service card);

a collection mechanism for communicating with said mobile communication

terminal to collect information relating to the internal state of said mobile communication

terminal (Column 6 lines 48-68, column 7 lines 1-2) and

a storage mechanism for storing therein information that has been collected by

said collection mechanism (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element

132).

However, Simpson et al. do not disclose collecting during execution of test

programs on said test program execution unit. Rimpela et al. disclose collecting during

execution of test programs on said test program execution unit (Abstract, column 6 lines

26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpela et al.

disclose running tests on a control block). Therefore it would have been obvious to one

of ordinary skill in the art at the time of the invention to collect information during

execution of test programs on the test program execution unit, as taught by Rimpela et

al., in the method of Simpson et al. for the purpose of determining and controlling

delays, data to be transmitted and desired functions of the mobile station (as suggested

by Rimpela et al. in column 5 lines 33-45).

Consider claim 36, Simpson et al. disclose a mobile communication terminal in

which an external module for executing test programs is installed (Abstract, column 4

lines 49-52), said mobile terminal comprising:

an acquisition mechanism for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state)); and

an output mechanism for supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122).

However, Simpson et al. do not specifically disclose acquiring during said test programs. Rimpela et al. disclose acquiring information during the test programs (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpela et al. disclose running tests on a control block). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to acquire information during the test programs, as taught by Rimpela et al., in the method of Simpson et al. for the purpose of determining and controlling delays, data to be transmitted and desired functions of the mobile station (as suggested by Rimpela et al. in column 5 lines 33-45).

Consider claim 37, Simpson et al. disclose a mobile communication system comprising

a mobile communication terminal; and

an external module for installation in said mobile communication terminal (Abstract, column 4 lines 49-52);

wherein said mobile communication terminal comprises:

an acquisition mechanism for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state)); and

an output mechanism for supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122);

and wherein said external module comprises:

a program execution unit for performing programs (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4);

a collection mechanism for collecting information that has been supplied by said output mechanism of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and

a storage mechanism for storing therein information that has been collected by said collection means (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

However, Simpson et al. do not specifically disclose collecting information for test programs on said program execution unit. Rimpela et al. disclose collecting information for test programs on said test program execution unit (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpela et al. disclose running tests on a control block). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to collecting information for test

programs, as taught by Rimpela et al., in the method of Simpson et al. for the purpose

of determining and controlling delays, data to be transmitted and desired functions of

the mobile station (as suggested by Rimpela et al. in column 5 lines 33-45).

Consider claim 38, Simpson et al. disclose a method for communication by

executing programs in a mobile communication terminal (Column 1 lines 16-30, column

2 lines 65-68, column 3 lines 1-4), an external module being installed in said mobile

communication terminal (Abstract, column 4 lines 49-52), said method comprising steps

of:

requesting said mobile communication terminal, by said external module, to

execute a communication protocol sequence (Column 4 lines 53- 57);

executing, by said mobile communication terminal, said communication protocol

sequence in accordance with said request by said external module (Column 4 lines 53-

57);

acquiring, by said mobile communication terminal, information relating to the

internal state of said mobile communication terminal (Column 6 lines 48-68, column 7

lines 1-2, where Simpson et al. disclose customizing the operation (information relating

to the internal state));

supplying, by said mobile communication terminal, the acquired information to

said external module (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al.

disclose customizing the operation (information relating to the internal state) and this

information is stored on the SIM card);

collecting, by said external module, information that has been supplied by said

mobile communication terminal as part of said program (Column 6 lines 48-68, column

7 lines 1-2); and

storing, in said external module, the collected information from said program

(Column 6 lines 48- 68, column 7 lines 1-2, figure 3 element 132). .

However, Simpson et al. do not specifically disclose collecting information for test

programs. Rimpela et al. disclose collecting information for test programs (Abstract,

column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where

Rimpela et al. disclose running tests on a control block). Therefore it would have been

obvious to one of ordinary skill in the art at the time of the invention to collect

information for test programs, as taught by Rimpela et al., in the method of Simpson et

al. for the purpose of determining and controlling delays, data to be transmitted and

desired functions of the mobile station (as suggested by Rimpela et al in column 5, lines

33-45).

Response to Amendment

4.   Applicant's arguments with respect to claims 20-38 have been considered but are

moot in view of the new ground(s) of rejection.

5.   Applicant's arguments filed April 12, 2007 have been fully considered but they

are not persuasive.

Applicant argues that certain claim terms must be limited to the meaning

described in the instant specification. However claims should be given their broadest

reasonable interpretation, therefore the meaning used in the rejection is correct. If

applicant intends for the claims to be limited to a specific meaning, this should be present in the claims.

Conclusion

6.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

9.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177.

10.   The central fax phone number for the Office is 571-273-8300.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

11.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Philip Sobutka

(571) 272-7887

PHILIP J. SOBUTKA
PATENT EXAMINER